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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221837
Party	Defendant Bad Yogi LLC
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Attachments	BadYogiAnswerFinal.pdf(1237350 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of: Application Serial No. 86432152
For the Mark of BAD YOGI
Published in the Official Gazette on April 7, 2015

Bibji Inderjit Kaur Puri,

Opposer,

v. Opposition No. 91221837

Bad Yogi, LLC,

Applicant.

Applicant's Motion to Strike and Answer to Notice of Opposition

Motion to Strike – Service Improper

Applicant, Bad Yogi, LLC ("Applicant"), moves to strike the Notice of Opposition filed by Bibji Inderjit Kaur Puri ("Opposer") against application for registration of trademark BAD YOGI, Serial No. 86432152 filed on October 23, 2014, and published in the Official Gazette of April 7, 2015, because the Notice of Opposition was not properly served. Opposer's certificate of service avers that it was served on the Applicant on May 6, 2015, but Opposer did not mail the Notice of Opposition to Applicant either before or on May 6. *See* **Exhibit A**. The Trademark Board has emphasized that "[p]roof of service is meaningless in the absence of actual service in accordance with the statements contained in the proof of service. The requirement of the rules is for proof of service, not a promise to make service at some time in the future." *Springfield, Inc. v. XD*, 86 USPQ2d 1063 (TTAB 2008). Opposer failed to comply with proof of service when it assured the board upon filing that it effectuated service on May 6, 2015, but failed to serve

Applicant on the date it promised. Therefore, applicant respectfully requests that the board find the certificate of service improper and strike Opposer's Notice of Opposition.

Answer to Notice of Opposition

In the alternative, if the Board finds service was proper, Applicant, Bad Yogi, LLC ("Applicant"), for its answer to the Notice of Opposition filed by Bibji Inderjit Kaur Puri ("Opposer") against application for registration of trademark BAD YOGI, Serial No. 86432152 filed on October 23, 2014, and published in the Official Gazette of April 7, 2015, pleads and avers as follows:

1. The allegations of paragraph 1 are denied.
2. The allegations of paragraph 2 are denied.
3. The allegations of paragraph 3 are denied.
4. Applicant admits that Opposer purports to own and use the marks listed in paragraph 4; otherwise the allegations set forth in paragraph 4 are denied.
5. Applicant is without knowledge of the allegations set forth in paragraph 5, therefore denied.
6. Applicant is without knowledge of the allegations set forth in paragraph 6, therefore denied.
7. Applicant is without knowledge of the allegations set forth in paragraph 7, therefore denied.
8. Applicant is without knowledge of the allegations set forth in paragraph 8, therefore denied.
9. Applicant is without knowledge of the allegations set forth in paragraph 9, therefore denied.
10. Applicant is without knowledge of the allegations set forth in paragraph 10, therefore denied.
11. Applicant is without knowledge of the allegations set forth in paragraph 11, therefore denied.
12. Applicant is without knowledge of the allegations set forth in paragraph 12, therefore denied.
13. Applicant is without knowledge of the allegations set forth in paragraph 13, therefore denied.
14. Applicant is without knowledge of the allegations set forth in paragraph 14, therefore denied.

15. The allegations of paragraph 15 are denied. Applicant's mark does not interfere or cause confusion as the requested mark is for a completely different category of goods (apparel and online yoga instruction videos) than the Opposer's goods (food and bath products). Applicant's products are not in the zone of natural growth for bath and beauty; rather, apparel and online yoga instruction represent a completely different market from that which Opposer currently has involvement.
16. The allegations in paragraph 16 are otherwise denied. Applicant has disclaimed any use of the word "YOGI" standing alone, which is the only similarity. The trademark laws do not allow Opposer to preclude every commercial use incorporating the word YOGI with a modifying and differentiating adjective, noun, etc.
17. The allegations in paragraph 17 are admitted.
18. The allegations in paragraph 18 are denied. Opposer has not demonstrated use of each of the marks claimed in its YOGI mark. Additionally, Opposer claims it uses its marks in connection with tea, cereal, snack food, juices, herbs and spices, bath products, and beauty products. Apparel and online yoga instruction videos are not items that represent a natural expansion of the items that Opposer claims it uses its marks to represent. Therefore, Applicant's use of BAD YOGI for the goods at issue predates Opposer's use.
19. Admitted that the proposed work includes the word YOGI. Denied that it is a derivative.
20. The allegations in paragraph 20 are denied.
21. The allegations in paragraph 21 are denied. Opposer's mark does not meet the criteria to be considered a famous mark.
22. The allegations in paragraph 22 are denied.
23. The allegations in paragraph 23 are denied.

24. The allegations in paragraph 24 are denied.

25. The allegations in paragraph 25 are denied. To the extent that Opposer is attempting to make out separate federal claim for false designation of origin, the Trademark Trial and Appeal Board does not have jurisdiction to hear such claims. A federal claim for false designation of origin is based on state law claims of unfair competition, which the Trademark Trial and Appeal Board does not have jurisdiction over.

26. The allegations in paragraph 26 are denied.

27. The allegations in paragraph 27 are denied. The Trademark Trial and Appeal Board does not have jurisdiction to hear claims based on state law unfair competition statutes.

28. The allegations in paragraph 28 are denied.

First Defense
Disclaimer

29. Applicant has already disclaimed any right to use YOGI standing alone. In seeking registration for its mark, Applicant submitted a disclaimer that "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "YOGI" APART FROM THE MARK AS SHOWN." Given the distinct categories of products, divergent trade channels, and differences in the mark itself, Applicant believes that there is no likelihood of confusion. *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items). Other registrants with products in different classes than Opposer have trademarks containing Yogi combined with another word. Since Bad Yogi's products are in different classes than Opposer's and it has disclaimed the right to use Yogi standing alone, registration should be allowed.

Second Defense
No Likelihood of Confusion

30. Opposer's products are sufficiently different from Applicant's, such that no likelihood of confusion could occur between the two. Opposer attempts to define the "natural scope of expansion" extremely broadly, as to include all products that a healthy person could potentially buy. Opposer, however, has not shown a relationship between the products offered by it and those offered by applicant sufficient to support a likelihood of confusion. *See In Re Grand Prix Imp. Inc.*, SERIAL 77408025, 2010 WL 2513866, at *2 (T.T.A.B. June 2, 2010) (finding that audio equipment was not related enough to automobile parts and accessories to support a likelihood of confusion, even where the parties customers were both individuals with automobiles). The bath and beauty products offered by the Yogi marks are sufficiently different from the Yoga clothing and downloadable videos offered by Bad Yogi.

Third Defense
No Dilution

31. Opposer cannot show that any of its marks have been diluted as none of the marks discussed are famous marks. Additionally, Opposer has not pled all of the requirements for a dilution claim, as Opposer has failed to state when Opposer's mark rose to the status of a famous mark and whether Applicant's commercial use of its requested mark has resulted in dilution of any of Opposer's marks. These allegations are essential in order for the Trademark Trial and Appeal Board to find that dilution has occurred.

Fourth Defense
TTAB Does Not Have Jurisdiction Over State Law Claims

32. To the extent that any of Opposer's claims are based on state unfair competition law, those claims should not be decided as such issues are not properly heard before the Trademark

Trial and Appeal Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) ("[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings."), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd*, 552 U.S. 1109 (2008).

Fifth Defense
No Standing

33. To the extent Opposer claims only a beneficial interest in the asserted marks, Opposer lacks standing to oppose the application. *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999) ("[A]n opposer has been required to show that he has a 'real interest' in the outcome of a proceeding in order to have standing.").

WHEREFORE, Applicant respectfully requests that the mark issue over Opposer's opposition.

Respectfully submitted, this the 15th day of June, 2015.

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served on Counsel for Opposer by mailing said copy on the date undersigned via Certified Mail, Return Receipt Requested to:

Michael A. Long
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Date: June 15, 2015

/David L. Luikart/
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EXHIBIT
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